

## REMARKS

Applicants have reviewed the July 16, 2007 Office Action finally rejecting certain claims of the subject application and further setting forth objections to certain claims. Based upon the content of this Office Action, Applicants believe that a telephonic interview with the Examiner Nicholson and perhaps with supervisor Gene Crawford would be useful in forwarding the examination of the subject application.

The three issues the Applicants believe should be addressed in the interview are as follows:

- (1) the objection to product-by-process Claims 27, 29, 45 and 59;
- (2) the rejection of Claims 27, 29, 45 and 59 under 35 USC §112; and
- (3) the rejection of Claims 27, 29, 45 and 59 under both 35 USC §102(b) and 35 USC§103(a).

The following is Applicants present understanding of these issues:

(1) Objection to Product-by-Process Claims

(a) Office Action mailed January 17, 2007 – the product-by-process claims do not comply with 37 CFR 1.75(c) and are thus improper dependent claims.

(b) Response to Office Action mailed on June 12, 2007 – The Manual of Patent Examining Procedure specifically states that 37 CFR 1.75(c) does not apply to product-by-process claims.

(c) Office Action mailed July 16, 2007 – “Applicant argues ... this rule [37 CFR 1.75(c)] does not apply to product-by process claims”. According to the Examiner, the rule does apply. [page 2 of Office Action]

(d) Present status – Applicants can only conclude that the Examiner does not believe he is bound by the MPEP. A telephonic interview would be helpful to address what appears to be a miscommunication between the parties.

## (2) Section 112 Claim Rejection

(a) Office Action mailed January 17, 2007 – the product-by-process claims directed to a “sheet” made in accordance with a “method of conditioning an edge of a stack of sheets” do not comply with the “first paragraph” of 35 USC §112. Reference is made to *both* the written description requirement (“The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention”) *and* to the enablement requirement (“[T]he claims presents a non-enablement problem because one or ordinary skill in the art would not be able to condition just a single sheet per Applicant’s claimed process.”).

(b) Response to Office Action mailed on June 12, 2007 – Applicants believed that the Examiner was confusing the “written description requirement” of the first paragraph of §112 with the separate “enablement requirement” of that paragraph and was treating the two requirements as one requirement. As a result of this apparent confusion, Applicants assumed that the rejection was for lack of a written description, largely because it is not conceivable to Applicants that the Examiner would seriously contend that a process for conditioning a stack of sheets does not enable one of ordinary skill to make a single sheet – removing a sheet from a stack is not a great step in the art. Addressing the rejection as one of a written description, Applicants pointed out in the Response several instances where is single

conditioned sheet is described and actually depicted in the drawings of the subject application.

(c) Office Action mailed July 16, 2007 – the §112 rejection is maintained with the confusing reference again being made to both a lack of written description and lack of enablement. There is *not one word* in this Office Action addressing Applicants arguments that the subject application makes repeated reference to individual conditioned sheets and thus complies with the written description requirement.

(d) Present status – Applicants do not know if the §112 rejection is based upon a lack of written description, lack of enablement or both. The statement that “one of ordinary skill in the art would not know be able to condition a single sheet per Applicant’s process” is not understood because there is no such claim in the application. Applicants would propose that the rejected claims be amended to recite “a sheet from a stack conditioned in accordance with the method of Claim ...” but it is not clear if this adequately addresses the Examiner’s concern. Again, a telephonic interview would be helpful to address this issue.

### (3) Rejections under 35 USC §102(b)/103(a)

(a) Office Action mailed January 17, 2007 – the product-by-process claims were all rejected for being either anticipated or obvious in view of two separate items of prior art. A bare citation is made to MPEP 2113. This is the *entire substance* of this rejection. The cited MPEP section heading reads: “Product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps”.

(b) Response to Office Action mailed on June 12, 2007 – Applicants point out that the Examiner must give patentable weight “to the structure implied by the steps” as indicated by the MPEP heading quoted and as indicated by the legal

authority cited by Applicants. Applicants went on to describe in some detail why the structure implied by the claimed process difference significantly from that structure implied by the processes disclosed in the cited prior art.

(c) Office Action mailed July 16, 2007 – the §102/103 rejections are maintained. There is *not one word* in this rejection that addresses the substantive arguments made by Applicants regarding the differing structures implied by the differing processes. The rejection is only - "See MPEP 2113 and ¶ 1".

(d) Present status – Applicants do not know, and the Examiner has not stated, the grounds for rejecting the product-by-process claims in view of the prior art. As a consequence, Applicants are unable to respond. If the Examiner is not persuaded by Applicants arguments of differing structures, he should state so rather than simply referring to "MPEP 2113" and nothing more. This issue should be discussed in the proposed interview so Applicants can determine its next course of action.

In summary, Applicants request that the Examiner call the undersigned attorney at (415) 433 -2250 Ext 101 to set up a mutually acceptable time for an interview. Preferably, the interview can be held no later than early August of 2007.

Respectfully submitted,

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